REMARKS

35 USC 112

The Examiner rejects Claim 10 for failing to comply with the written description. Specifically, the Examiner rejects to "printing, by a computer, the associated attributes that do not match any of the determined attributes according to the PDL commands." For the sake of furthering prosecution, Applicants remove this language.

35 USC 103(a)

The Examiner rejects Claims 10-12 and 28-29 under 35 USC 103(a) as being unpatentable over Jackelen (USPN 6,823,147) in view of Suzuki (USPN 5,923,013).

When a user wants to print information from a source file, the data in the source file typically goes through several conversion stages. For example, the source file can be translated into a page description format, such as PostScript, PDF, or PCL. Page 2. The printer prints the data according to the page description format. Frequently, however, the printed version of the data looks different from the data as displayed on the screen. This is because data can become lost or improperly converted during the translation into the page description format. Page 3.

Claim 10 recites a method for analyzing a print job that helps prevent these translation problems by providing the user with reports on print attributes that are associated with objects in a print job.

Applicants amend Claim 10 to recite that once the computer has processed each object in the print job, the computer reports any global printer settings and printer factors that affect the print job. Support for this amendment can be found, for example, on page 8, lines 22-24. Applicants further amend Claim 10 to recite that reporting comprises any of printing a report and transmitting data for display on the computer. Support for this amendment can be found, for example, on page 8, lines 31-34. The reporting allows the user to determine whether the printer is functioning properly and that the global print settings are properly configured. Page 9.

Jackelen fails to teach or suggest reporting global printer settings and printer factors that may affect the print job. The user is only notified of the printer's capabilities if there is a discrepancy between the print job attributes and the printer capabilities. Column 4, lines 30-35.

Applicants further amend Claim 10 to clarify that the computer reports the results of any object with an associated print attribute that matches any determined attribute. The match is reported using the unique marker. The reporting comprises any of printing a report and transmitting data for display on the computer. For example, where the determined attribute is any text in Helvetica font, the unique marker is printing in shades of cyan, and the print job contains any text in Helvetica, the print job is printed with the text in Helvetica font also printed in shades of cyan. Page 11. In another example, the printer prints a report that specifies the page number and location of each object in color coded text, where the color codes convey identifying information about the matching attributes. Page 12.

These features are not taught or suggested by Jackelen. In Jackelen, print job attributes are compared to available printer resources. Column 4, lines 3-7. If there is no mismatch, the printer prints the print job. Column 4, lines 20-22. If there is a mismatch, the print job is placed on hold and the user is informed of the nature of the mismatch state. Column 4, lines 30-35. Thus, if there is an error in the translation from a print source to the page description format, because the print job is printed with the error, the user has no means for determining where the error is located.

Applicants have carefully reviewed Suzuki and find no teaching or suggestion of these features.

To establish a *prima facie* case of obviousness of a claimed invention, all the claimed features must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Because the combination of Jackelen and Suzuki fail to teach or suggest (1) reporting, by the computer, global printer settings and printer factors that may affect the print job; and (3) reporting, by the computer, the results of any object with an associated print attribute that matches any determined attribute using the

corresponding unique marker, the Examiner has failed to establish a *prima facie* case of obviousness.

Additional limitations recited in the dependent claims are not further discussed because the limitations discussed above are sufficient to distinguish the claims from the cited art.

Conclusion

In view of the above, Applicants respectfully posit that the pending claims are allowable. The Examiner is invited to please contact Applicants' attorney at (650) 474-8400 should any questions arise.

Respectfully submitted,

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